IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant(s)	:	Erik Romanski et al.
U.S. Serial No.	:	09/923,936
Filed	:	August 7, 2001
For	:	FLOTATION COATING FOR WATER TRANSPORT
Examiner	:	Edwin L. Swinehart
Group Art Unit	:	3617

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: **MAIL STOP APPEAL BRIEF-PATENTS, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450**, on ~~August 22, 2005~~. JANUARY 25, 2006

Ronald R. Santucci, Reg. No. 28,988
Name of Applicant, Assignee or Registered Representative

Signature

January 25, 2006
Date of Signature

REPLY BRIEF UNDER 37 C.F.R. § 41.41

MAIL STOP APPEAL BRIEF-PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is being filed in response to the Examiner's Answer dated June 23, 2005. This Reply Brief is filed in triplicate.

ARGUMENT

This Reply Brief is being filed in response to several points of argument raised by the Examiner in the Examiner's Answer. It is believed that no fee is required for the consideration of the Reply Brief. If, however, a fee is due, the Assistant Commissioner is authorized to charge such fee, or credit any over payment to Deposit Account No. 50-0320.

Claims 1-3 were rejected under 35 U.S.C. §103 as allegedly being unpatentable over U.S. Patent No. 2,997,973 to Hawthorne et al. ("Hawthorne") in view of U.S. Patent No. 4,897,303 to McCullough Jr. et al. ("McCullough"). The rejections are traversed for at least the following reasons. None of the cited documents either alone or in combination, teach, suggest, disclose or motivate a skilled artisan to practice the instantly claimed invention.

The instant invention is directed to a flexible fluid containment vessel for the transportation and/or containment of cargo comprising a fluid or fluidisable material, said vessel comprising, *inter alia,* a means for rendering the tubular structure buoyant comprising forming the fabric having at least one thermoplastic or thermoset coating that renders the fabric buoyant. Such an invention is neither disclosed, taught, enabled nor suggested in the cited documents.

Contrary to the assertion of the Examiner, neither Hawthorne nor McCullough, either alone or in combination, teach, suggest, disclose or motivate a skilled artisan to practice the instantly claimed invention. More specifically, the combination of the cited documents do not teach, suggest or motivate a skilled artisan to practice the claimed flexible fluid containment vessel for the transportation and/or containment of cargo

comprising a fluid or fluidisable material, said vessel comprising, *inter alia,* a means for rendering the tubular structure buoyant comprising forming the fabric having at least one thermoplastic or thermoset coating that renders the fabric buoyant.

Next, the Examiner contends that Hawthorne provides motivation to one skilled in the art to enhance the buoyancy of the fabric so that it could be used with fluidisable cargo that does not provide sufficient buoyancy on its own. However the Examiner acknowledges that Hawthorne does not disclose a thermoset or thermoplastic coating that renders the fabric buoyant. In contrast, Hawthorne teaches that buoyancy of the vessel is created by the contents of the vessel. *Hawthorne*, col. 1, lines 30-32. Thus, since Hawthorne already teaches the use of the vessel's contents to provide the necessary buoyancy, one skilled in the art would not be motivated to look at McCullough to provide additional buoyancy.

In fact, in contrast to the view of the Examiner, Applicants urge that the disclosure of Hawthorne would steer a skilled artisan away from having at least one thermoplastic or thermoset coating that renders the fabric buoyant. Moreover, in contrast to the Examiner's view, the increase of buoyancy of a floating object is not always a desirable attribute as it can result in instability and undesirable towing or handling characteristics. Thus, given the disclosure of Hawthorne, there would be no motivation to one skilled in the art to look at McCullough, and as a result to incorporate at least one thermoplastic or thermoset coating, rendering the fabric buoyant, in order to achieve the instant flexible fluid containment vessel. Consequently, the disclosure of Hawthorne alone or in view of McCullough would not motivate a skilled artisan to practice the instantly claimed invention.

Moreover, the Examiner has relied upon the knowledge of one skilled in the art as providing the necessary motivation for the combination of Hawthorne and McCullough. The Examiner, however, has failed to show that a person of ordinary skill in the art would have had a "reasonable expectation of success" in combining Hawthorne and McCullough. *See, e.g., Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1354 (Fed. Cir. 2003) ("A showing of obviousness requires a motivation or suggestion to combine or modify prior art references, coupled with a reasonable expectation of success."). Therefore, since "a reasonable expectation of success" has not been shown, the combination of references can only be based on hindsight. However, an obviousness rejection based on hindsight is impermissible. It is submitted that as there is no indication of a desire to increase buoyancy in Hawthorne, the application of the teachings of McCullough can only be motivated by hindsight and should therefore be withdrawn.

It is well-settled that "obvious to try" is not the standard upon which an obviousness rejection should be based. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1599-1600 (Fed. Cir. 1988). The Examiner alleges that increasing the buoyancy of the vessel described in Hawthorne would be obvious to one of skill in the art. Applicants respectfully disagree and urge that there is no suggestion or recognition in Hawthorne that such increased buoyancy is desirable or that Hawthorne apparatus will sink without increasing buoyancy. In contrary, Hawthorne teaches that the necessary buoyancy of the vessel is created by the contents of the vessel. *Hawthorne*, col. 1, lines 30-32. Accordingly, as "obvious to try" would be the only standard that would lend the Section

103 rejection any viability, the rejection must fail as a matter of law. Therefore, applying the law to the instant facts, the rejection is fatally defective and should be removed.

Accordingly, for at least the reasons described above, the documents cited by the Examiner fail to render claims 1-3 unpatentable under 35 U.S.C. §103(a). Therefore, the rejected claims should be allowed.

CONCLUSION

It is respectfully submitted that the Examiner erred in rejecting claims 1-3 and therefore, Appellants request a reversal of these rejections by this Honorable Board. It is further submitted that the Examiner's objections/rejections and materials set forth in the Examiner's Answer should be reversed and allowance of this application should be mandated.

Respectfully submitted,

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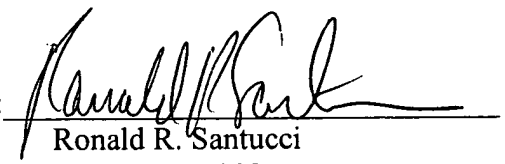
Attorneys for Appellants

By: 

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